



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,217	10/28/2003	Ludomir A. Budzyn	B-1	4967

7590 06/15/2006  
Ludomir A. Budzyn  
7 Edgewood Place  
Maplewood, NJ 07040

EXAMINER

WASSUM, LUKE S

ART UNIT	PAPER NUMBER
----------	--------------

2167

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/695,217

**Applicant(s)**

BUDZYN, LUDOMIR A.

**Examiner**

Luke S. Wassum

**Art Unit**

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20031028</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***The Invention***

1. The claimed invention is a method for investigating intellectual property related to a reference piece of intellectual property. In one embodiment, the user inputs a trademark, and the system generates a list of patents and patent applications which are related in some way to said trademark.

### ***Priority***

2. The Applicant's claim to domestic priority under 35 U.S.C. § 119(e) based upon U.S. Provisional Patent Application 60/421,710, filed 28 October 2002, is acknowledged.

### ***Information Disclosure Statement***

3. The Applicants' Information Disclosure Statement, filed 28 October 2003, has been received and entered into the record. Since the Information Disclosure Statement complies with the provisions of MPEP § 609, the references cited therein have been considered by the examiner. See attached form PTO-1449.

### ***Drawings***

4. The application includes informal (handdrawn) drawings. While these drawings are acceptable for examination purposes, the examiner encourages the Applicant to submit formal drawings at the earliest opportunity. Early submission of formal drawings will help expedite post-allowance processing and publication of the issued patent.

***Claim Objections***

5. Claims 13 and 14 are objected to because of the following informalities:

Claim 13 contains a typographical error: 'ownere' should be 'owner'.

Claim 14 contains a typographical error: 'servies' should be 'services'.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Regarding claim 1, this claim recites the process of identifying intellectual property related to a reference piece of intellectual property, but fails to recite a tangible result, a requirement for compliance with the provisions of 35 U.S.C. § 101 for a process that can be interpreted as being implemented through software.

For a result to be tangible, it must be more than just a thought or a computation; it must have real-world value rather than an abstract result. For instance, an additional step that included either storing the identified pieces of second intellectual property in a database, or displaying said identified pieces of second intellectual property to a user would constitute a tangible result. Claim 1, however, merely cites 'identifying pieces of second intellectual property' as the result.

Art Unit: 2167

This interpretation of 35 U.S.C. § 101 is consistent with the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, published on 26 October 2005, which can be found at

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf),

particularly with respect to ANNEX IV Computer-Related Nonstatutory Subject Matter, beginning on page 50.

9. Claims 2-16, fully incorporating the deficiencies of their parent claim 1, are likewise rejected.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lee** (U.S. Patent 6,694,331).

12. Regarding claim 1, **Lee** teaches a method for investigating intellectual property related to a reference piece of intellectual property as claimed, said method comprising:

- a) providing a first database of discrete pieces of first intellectual property, said pieces of first intellectual property each including an associated set of first characteristics (see disclosure that the system supports the analysis of different types of intellectual property information, such as patents, trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10, lines 34-40; see also col. 11, line 63 through col. 12, line 7);
- b) providing a second database of discrete pieces of second intellectual property, said second intellectual property being of a different type from said first intellectual property (see disclosure that the system supports the analysis of different types of intellectual property information, such as patents, trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10, lines 34-40; see also col. 11, line 63 through col. 12, line 7);
- c) searching said first database to identify said pieces of first intellectual property having predetermined characteristics in common with the reference piece of intellectual property (see disclosure of the identification of a 'source grouping' of intellectual property information, col. 8, lines 17-28; see also designation of a 'source grouping', col. 10, lines 34-45);
- d) developing at least one query based on at least a portion of said first characteristics of said identified pieces of first intellectual property (see disclosure of the use of a source grouping to generate a list of 'different elements' found in the source grouping, col. 8, line 56 through col. 9, line 15; see also col. 10, line 61 through col. 11, line 39; see also col. 11, line 63 through col. 12, line 29 ); and

e) searching said second database to identify said pieces of second intellectual property satisfying said at least one query (see disclosure that the created 'field of search' can be used as a search query to be executed by a local or remote database, col. 12, lines 26-29; see also disclosure that the invention can be used to variously search and/or analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

13. Regarding claim 2, **Lee** additionally teaches a method for investigating intellectual property wherein said pieces of first intellectual property are selected from the group consisting of registered trademarks, unregistered trademarks and applications to register trademarks (see disclosure that the invention can be used to variously search and/or analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

14. Regarding claims 3 and 5, **Lee** additionally teaches a method for investigating intellectual property wherein said pieces of second intellectual property are selected from the group consisting of patents and patent applications (see disclosure that the invention can be used to variously search and/or analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

15. Regarding claims 4 and 6, **Lee** additionally teaches a method for investigating intellectual property wherein the reference piece of intellectual property is a trademark (see disclosure of the receipt of input data or signals from the user identifying select intellectual property to form a 'source

Art Unit: 2167

grouping' of intellectual property information, col. 8, lines 17-28; see also the fact that the intellectual property information can include trademarks, col. 8, lines 11-17).

16. Regarding claim 7, **Lee** additionally teaches a method for investigating intellectual property wherein said step of searching said first database includes searching said first database to identify said pieces of first intellectual property which are identical matches to the reference piece of intellectual property (see disclosure that the select intellectual property information input by the user may be individual intellectual property identified by native indicia, which would include identifying trademarks which identically matched an input native indicia, col. 8, lines 30-34).

17. Regarding claim 8, **Lee** additionally teaches a method for investigating intellectual property wherein said step of searching said first database includes searching said first database to identify said pieces of first intellectual property which include at least one search term in common with at least a portion of the reference piece of intellectual property (see disclosure that the select intellectual property information input by the user may be individual intellectual property identified by native indicia, which would include identifying trademarks which have, for instance, a common assignee, col. 8, lines 30-34).

18. Regarding claim 9, **Lee** additionally teaches a method for investigating intellectual property further comprising sorting said identified pieces of first intellectual property (see disclosure of the sorting of search results, col. 4, lines 49-57 et seq.).



Art Unit: 2167

19. Regarding claim 10, **Lee** additionally teaches a method for investigating intellectual property wherein said step of sorting includes comparing each of said identified pieces of first intellectual property with the reference piece of intellectual property to determine degree of similarity therebetween (see disclosure of the sorting of search results based upon relevancy or weighted relevancy, col. 4, lines 49-57 et seq.).

20. Regarding claim 11, **Lee** additionally teaches a method for investigating intellectual property wherein said steps of developing at least one query and searching said second database are sequentially conducted for each identified piece of first intellectual property (see disclosure that each piece of intellectual property in the source grouping is reviewed in order to ascertain different elements to be used as search criteria, col. 8, lines 56-63; see also col. 10, line 61 through col. 11, line 2; see also col. 11, line 63 through col. 12, line 7; also note that for at least the cases where none or exactly one piece of first intellectual property is identified, the execution of said developing step and searching step is de facto sequential).

21. Regarding claim 12, **Lee** additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes the name of the owner of the associated said piece of first intellectual property, and wherein said at least one query includes a first query, said first query being to identify all pieces of second intellectual property in which the owner of the respective said identified piece of first intellectual property has rights (see disclosure that the search engine performs searches based on input data such as Inventor and Assignee, col. 4, lines 15-29).

Art Unit: 2167

22. Regarding claim 13, **Lee** additionally teaches a method for investigating intellectual property wherein said first query being to identify all pieces of second intellectual property in which the owner of the respective said identified piece of intellectual property has recorder ownership rights (see disclosure that the search engine performs searches based on input data such as Inventor and Assignee, col. 4, lines 15-29).

23. Regarding claim 14, **Lee** additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes the goods or services of the associated said piece of first intellectual property, and wherein said at least one query includes a second query, said second query being to identify all said pieces of second intellectual property which relate to the goods or services of the respective said identified piece of first intellectual property (see disclosure that the intellectual property can be searched based on classification, including the classification of goods and services for trademarks, col. 6, lines 35-56).

24. Regarding claim 15, **Lee** additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes information relating to dates of first use of the associated said piece of first intellectual property, and wherein said at least one query includes a third query, said third query being to identify all said pieces of second intellectual property having a filing date or priority date after the dates of first use of the respective said identified piece of first intellectual property (see disclosure that the search engine performs searches based on input data such as Publication Date, Filing Date, Related Data and Priority Data, col. 4, lines 15-29).

25. Regarding claim 16, **Lee** additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes a classification of the associated said piece of first intellectual property, and wherein said at least one query includes a fourth query, said fourth query being to identify all said pieces of second intellectual property having a classification equivalent to the classification of the respective said identified piece of first intellectual property (see disclosure that the search engine performs searches based on input data such as International Classification, U.S. Classification, and Cross-Reference Classification, col. 4, lines 15-29).

### ***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Rivette et al.** (U.S. Patent 5,991,751) teaches a system for processing data related to patent information and associated non-patent information, including patent mapping, document mapping, patent citation analysis and patent clustering.

**Rivette et al.** (U.S. Patent 5,991,780) teaches a system for processing data related to patent information and associated non-patent information, including patent mapping, document mapping, patent citation analysis and patent clustering.

**Donner** (U.S. Patent 5,999,907) teaches an intellectual property audit system for valuing an intellectual property portfolio.

**Donner** (U.S. Patent 6,154,725) teaches an intellectual property audit system for valuing an intellectual property portfolio.

**Donner** (U.S. Patent 6,263,314) teaches an intellectual property audit system for valuing an intellectual property portfolio.

**Barney** (U.S. Patent 6,289,341) teaches an intelligent agent for identifying intellectual property infringement issues in computer network sites.

**Rivette et al.** (U.S. Patent 6,339,767) teaches a system for processing data related to patent information and associated non-patent information, including patent mapping, document mapping, patent citation analysis and patent clustering.

**Coakley** (U.S. Patent 6,470,318) teaches a method for brokering trademarks between trademark owners and potential trademark buyers.

**Rivette et al.** (U.S. Patent 6,499,026) teaches a system for visualizing the citation relationships between patents through the use of hyperbolic trees.

**Lee** (U.S. Patent 6,662,178) teaches a system for searching and organizing intellectual property.

**Lee** (U.S. Patent Application Publication 2002/0138297) teaches a system for searching and organizing intellectual property.

**Lee** (U.S. Patent Application Publication 2002/0138465) teaches a system for searching and organizing intellectual property.

**Lee** (U.S. Patent Application Publication 2002/0138474) teaches a system for searching and organizing intellectual property.

**Lee** (U.S. Patent Application Publication 2002/0138475) teaches a system for searching and organizing intellectual property.

**Arkin et al.** (U.S. Patent Application Publication 2002/0152261) teaches a system for preventing the infringement of intellectual property rights.

**Calistri-Yeh et al.** (The MAPIT Patent-TSV System") is a User's Guide for the MAPIT patent analysis system.

Art Unit: 2167

**Feldman** ("Manning & Napier Information Services Announces CINDOR, a Multi-Language Search-and-Retrieval System") teaches the release of the CINDOR system.

**Gow** ("Intellectual Asset Profiling Systems") is a review of contemporary intellectual asset profiling tools.

Art Unit: 2167

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Art Unit: 2167

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Luke S. Wassum", with a long horizontal flourish extending to the right.

Luke S. Wassum  
Primary Examiner  
Art Unit 2167

lsu  
12 June 2006